APPENDIX A

Opinion of the Court of Appeals

IN THE

UNITED STATES COURT OF APPEALS

FOR THE SEVENTH CIRCUIT

Nos. 16213, 16214, 16215

SEPTEMBER TERM, 1967 SEPTEMBER SESSION, 1967

Nos. 16213 and 16215

DAVID R. BLAKE, an individual, and EVER-LEVEL GLIDES, INC., a corporation,

Plaintiffs-Appellees (Cross-Appellants),

v.

THE BASSICK COMPANY, a corporation, and STEWART-WARNER CORP., a corporation,

Defendants-Appellants (Cross-Appellees).

No. 16214

STEWART-WARNER CORP., a corporation,

Plaintiff-Appellee,

v.

AMERICAN SEATING COMPANY, a corporation,

Defendant-Appellant.

Appeals from the United States District Court for the Northern District of Illinois, Eastern Division.

February 26, 1968

Before KILEY, SWYGERT and FAIRCHILD, *Circuit Judges.*

KILEY, *Circuit Judge*. Plaintiffs Blake and Ever-Level Glides, Inc. (Ever-Level) sued defendant The Bassick Company (Bassick) for infringement of the Blake patent No. 2,704,663, and Stewart-Warner Corporation joined as a co-defendant. Bassick and Stewart-Warner then sued American Seating Company (American) and filed a counterclaim against Blake and Ever-Level, charging in both proceedings infringement of Stewart-Warner's Wasdell patent No. 2,503,143. The several proceedings were consolidated for trial and the trial resulted in judgment of validity and infringement in favor of Blake and Ever-Level against Bassick and Stewart-Warner,[1] and judgments of invalidity and non-infringement against Bassick and Stewart-Warner in their suit against American and on their counterclaim against Blake and Ever-Level.[2] Three separate appeals are taken from the proceedings below. We affirm in each appeal.

Both the Blake patent and the accused Stewart-Warner device are levelers designed to be attached to the legs of tables and chairs to prevent them from wobbling on uneven floors. The Blake patent works by means of a piston contained in a metal cup covered by a plate with a hole in it. A rod extends from the piston through the hole in the plate, and is attached to the furniture leg. The piston rests inside the metal cup which is filled with a substance called "bouncing putty." Bouncing putty is a plastic like substance which does not contract when subjected to sudden pressure but will slowly flow around the piston when the piston is subjected to a steady pressure and therefore will cause the piston to lower. A spring is attached to the bottom of the metal cup in order to force extension of the bottom of the cup into contact with a low spot in the floor. The rising and lowering of the piston due to the flow of the putty automatically adjusts the length of the furniture leg so as to keep all four legs in contact with the floor and prevent wobbling.

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[1] The court referred to a Master the question of the amount of damages suffered by Blake and Ever-Level.

[2] We will refer in this opinion to Bassick and Stewart-Warner as "Stewart-Warner," since joint briefs are filed in their behalf. We will refer to Blake and Ever-Level as "Blake," for the same reason.

The accused Stewart-Warner device works in essentially the same way except that instead of bouncing putty, Stewart-Warner uses unvulcanized silicone rubber, and instead of an inside spring reaching between the piston and the bottom of the metal cup, Stewart-Warner uses an exterior spring reaching from the top of the metal cup to table leg attachment means.

The Wasdell patent relied on by Stewart-Warner in its counterclaim is an automotive shock absorber which uses a piston cylinder and an unvulcanized elastomer as a means to cushion shock.

No. 16213

In appeal No. 16213 Stewart-Warner seeks to reverse the trial court's decision that the Blake patent is valid and is infringed by the defendant's device. The Blake cross-appeal seeks attorneys' fees incurred in defending against the counter-claim asserted by Stewart-Warner for infringement of the Wasdell patent, and treble damages for the infringement by Stewart-Warner of the Blake leveler. Blake asserts that the counterclaim was brought in bad faith and that the infringement of the Blake patent was willful.

Validity

Blake filed an application in England on April 26, 1948, for a patent covering his invention. This was about three months before he filed his application with the United States Patent Office, July 24, 1948,[3] and consequently to escape invalidity under 35 U.S.C. Sec. 186, Blake needed a "license . . . granted retroactively" for inadvertence under Sec. 184.[4] A retroactive license was issued to

[3] Blake's original application for a patent filed in 1946 was abandoned after the July, 1948, application was filed.

[4] "Except when authorized by a license obtained from the Commissioner a person shall not file or cause or authorize to be filed in any foreign country prior to six months after filing in the United States an application for patent . . . in respect of an invention made in this country. . . . The license may be granted retroactively where an application has been inadvertently filed abroad and the application does not disclose an invention within the scope of section 181 of this title."

Blake by the Patent Office. Stewart-Warner moved for summary judgment of invalidity under Sec. 186 on the ground that the retroactive license was obtained by misrepresentations to the Patent Office. It contends the court's denial of the motion was error.

The Sec. 186 point was originally raised in the Stewart-Warner answer to plaintiff's complaint. Blake at that time had not obtained a license, but after Stewart-Warner raised the point Blake filed an application for the retroactive license. The application stated that Blake had prepared the British patent application without the aid of a lawyer and was not aware of the license requirement. The license was initially denied because the affidavit filed with the license application did not explain why Blake did not know of the Sec. 184 license requirement since notice of the requirement appeared on the July 1946 and 1948 patent application receipts which Blake had presumably received. Blake filed a second affidavit which satisfied the Patent Office that neither receipt had been given to him by the attorney who had prepared the applications. The retroactive license then issued.

Stewart-Warner argues that Blake made false statements to the Patent Office in the license affidavit. It contends this is shown by different versions of the British filing given by Blake in his pre-trial deposition, in his license application, and in his trial testimony. Stewart-Warner insists that Blake falsely represented to the Patent Office that his attorney did not know of or prepare the British application, and that had this been known, the retroactive license would not have issued.

Stewart-Warner argues that Blake stated at a pre-trial deposition that Blake's attorney had prepared the British application and that this establishes that his contrary statements in his license affidavit were false. Stewart-Warner also points out that Blake showed some uncertainty in his testimony at trial, although he told essentially the same story there as he had in his affidavit.

At trial Blake was cross-examined with repect to the inconsistencies between his earlier deposition and his

license affidavit. The district court found that the retroactive license was "duly and legally" obtained. The court accepted Blake's story that he lacked knowledge of Sec. 184, that he prepared the *provisional specification* for the British application himself and that he hired a United States engineer to complete the specification; that his United States attorney did not know of the British patent when filing the 1948 patent application and he probably assumed that the British patent application was based on a disclosure in the 1946 Blake application, and that Blake did not receive the receipts, for the 1946 and 1948 applications, containing notice of the Sec. 184 provision. This question was briefed in the district court, and we see no reason to upset the district court's conclusion that the retroactive license was valid.[5]

Stewart-Warner also argues that Blake's patent is void by reason of a transaction between Blake and Rhodes, an engineer, in 1946, which it is claimed constituted a public use more than one year prior to the filing of Blake's patent application.

The court found that Rhodes' use of the patented device was experimental and not a sale. There is ample support for the finding. It is clear that the shipping to Rhodes of a single set of levelers had a double purpose, to establish the use of the trademark Levelmatic by shipping the devices in a box labeled with that name from Michigan to Pennsylvania; and for Rhodes, Blake's friend and adviser, to keep the device so that Blake could consult him about problems connected with preparing it for public use and commercial sales. There is no room for an inference that any demonstration by Rhodes "for people who came into his office" was other than ex-

[5] We are not persuaded that the excerpts in parallel claims from the provisional British application and the United States application in 1948 displayed in Stewart-Warner's reply brief show that Blake's sworn statements to the Patent Office and his testimony are "unbelievable fabrications." Blake testified that he prepared the provisional British application, and his attorney helped him prepare the United States application. The latter, in general, has a more professional like appearance with number references, presumably to figures, in specifications. The provisional has no reference to numbers and is phrased less concisely. This appears to be consistent with the Blake explanation.

perimental or that the mere shipment was a sale. Blake testified the device was not ready for sale until August, 1947, when commercial sales were first authorized by him.

The district court could not reasonably have thought that the Rhodes demonstrations were a covert commercial exploitation or that Blake's motive in the transaction was to exploit the invention to gain an advantage over competitors, under rules announced in *Koehring Co. v. National Automatic Tool Co.*, 362 F.2d 100 (7th Cir. 1966). The facts here justify the conclusion that defendants did not establish this defense. *Devex Corp.* v. *General Motors Corp.*, 321 F.2d 234, 239 (7th Cir. 1963).

Infringement

Stewart-Warner also argues that the trial judge's finding of infringement is clearly erroneous. We agree that the Blake claims do not read directly on the accused device. The spring in the Stewart-Warner device is external to the "dash pot" or container, while the spring in the Blake device is "between the bottom of the cylinder and the piston." The finding that the language of claims 1 and 2 of the Blake patent read directly on the Stewart-Warner spring is therefore clearly erroneous.

However, we do not consider clearly erroneous the court's finding that the accused device is the equivalent of the Blake device. The spring in the Stewart-Warner device is clearly the equivalent of the spring in Blake, despite the difference in its position. The district court concluded that the filler used in the accused device is the equivalent of the bouncing putty revealed in the Blake claims. If this finding was justified, the finding of infringement was proper, because assuming the filler is substantially the same, plainly the accused device operates substantially the same way, and achieves substantially the same result by use of substantially the same means as does the patent device. *Hunt v. Armour & Co.*, 185 F.2d 722, 728.

The essential properties of bouncing putty which enable it to fulfill its function in the Blake device are those of

resisting a sudden force and of deforming slowly to permit the movement of the piston under application of a steady force. These properties allow the device to adjust to an uneven floor by gradually extending the leg of the table to reach an uneven surface, while not reacting to sudden pressures.

Stewart-Warner argues that its filler does not have the solid and liquid properties of Blake's bouncing putty, and that for this reason there can be no equivalency. Blake's expert's, and we think even Stewart-Warner's expert's, testimony is to the contrary. Both substances have the same vital properties which permit their use in leveling devices. We think the entire evidence amply supports the finding of equivalency. *Graver Tank v. Linde Air Prod. Co.*, 339 U.S. 605, 607.

We see no merit in the contention that file wrapper estoppel precludes application of the doctrine of equivalents. Blake's original patent application called for the use or argano-siloxane but this application was rejected as unpatentable over prior art. He amended his claims to call for "a mass of bouncing putty," the only filler that would work in his device. His application on which the claim in suit issued stated that "it may be that other substances exist or may be discovered that have some or enough of the properties of the particular bouncing putty described to be used in its place." The court found that the Stewart-Warner filler was unavailable until 1952. It has the necessary properties for use in Blake's leveler and Blake is therefore not estopped from asserting its equivalency.

Nos. 16214 and 16215

Blake cross-appealed, No. 16215, from the judgment below in so far as it concluded that Stewart-Warner's infringement was not willful, and that the Stewart-Warner counter-claim was not vexatious. Blake sought treble damages for willful infringement and allowance of reasonable attorneys' fees for defending against the "vexatious" counter-claim for infringement of the Wasdell patent. American's appeal, No. 16214, is grounded on the same

claims of error, and the Blake and American briefs are consolidated on these points.

The district court's written decision on the merits contains 253 findings of fact and 33 conclusions of law. The district court originally found that the Stewart-Warner actions were brought in bad faith and the infringement of the Blake patent was willful. Subsequently the court on motion of Stewart-Warner eliminated those findings, stating that it had not intended to find willful and wanton infringement or to award treble damages and attorneys' fees.

The awarding of treble damages for willful and wanton infringement and reasonable attorneys' fees lay within the district court's discretion, *Union Carbide v. Graver Tank*, 282 F.2d 653, 673, and is vulnerable only to a charge of abuse of that discretion. In our opinion, Blake and American have not carried their burden of persuasion in this court. We have agreed with Stewart-Warner that their device did not read directly upon the Blake claims. We cannot agree with Blake, therefore, that Stewart-Warner copied the Blake device. Neither can we say that the court should have decided differently in light of the evidence of Stewart-Warner's original interest in a Blake license, its decision to develop its own device or instructions to engineers to avoid infringing Blake's invention, and its proceeding with marketing of its device on the advice of counsel that it did not infringe the Blake patent.

Blake and American argue that the district court should have allowed attorneys' fees because of Stewart-Warner's "vexatious" counterclaim and suit for infringement of the Wasdell patent. While this contention is arguable, we do not believe that the district court abused its discretion in refusing to award the amount of the fees to Blake. In the Patent Office file and in the testimony below there are many references to the Blake device as a shock absorber or having the capacity to absorb or avoid shock, and Blake himself testified that "to a degree" he would call his device a shock absorber. Although the district court found several reasons for deciding that the Blake

device did not infringe the Wasdell patent, the court expressly stated he had no intention of awarding attorneys' fees.

For the reasons given, the judgments are affirmed.

SWYGERT, *Circuit Judge,* dissenting.

I dissent from that portion of the majority opinion that denies the plaintiffs David R. Blake and Ever-Level Glides, Inc. and the defendant American Seating Company attorney fees for the vexatious and bad faith charge of infringement of the Wasdell patent advanced by Stewart-Warner.

The action by the plaintiffs for infringement of the Blake patent was filed on March 26, 1962. On June 13, 1962 Bassick answered the complaint. The Wasdell patent was purchased by Stewart-Warner on September 21, 1962. Two months after the purchase of the Wasdell patent, Bassick and Stewart-Warner filed a complaint and counterclaim alleging that the Wasdell patent, an invention directed to automotive shock absorbers, was infringed by the furniture levelers ("shock absorbing devices") of Blake, Ever-Level, and American Seating.

After first agreeing to adopt the findings and conclusions of Blake, Ever-Level, and American Seating that the charge of infringement based on the Wasdell patent was brought in bad faith and that an award of attorneys' fees was in order, the district judge subsequently amended his decision saying that he had "no intention . . . to award . . . attorneys' fees, and the adoption of the plaintiffs' findings in respect thereto was inadvertent." In my opinion, this action was erroneous and an abuse of discretion.

Despite his change of position, the district judge made the following relevant findings pointing to the many differences between the Wasdell shock absorber and the Blake leveler:

> An automotive shock absorber has always functioned and does modernly function to limit or "snub" re-

bound in the automobile chassis springs. The movable piston [of a shock absorber] is intended to be operated in opposite directions during a compression stroke and an expansion stroke with the filling medium in the shock absorber offering minimum resistance to the piston during the compression stroke and maximum resistance to the piston during the expansion stroke for the purpose of snubbing rebound in the automobile chassis springs. As a prerequisite to any proper functioning of the shock absorbers of Wasdell it is essential that the pistons be capable at all times to move in both directions within the cylinder and that the devices are not "bottomed out" in order to remain functional. The [furniture] levelers in question including the Bassick leveler are quite slow in operation requiring minutes rather than seconds to respond to forces applied to the levelers. The accused . . . leveler[s] is [are] intended to be fully compressed or "bottomed out" at least at one time or another during their operational use and within their specified ranges of operation while still remaining fully functional and operable to carry out its [their] intended purpose. The SS-91 filling material used by counter-defendants cannot be successfully used in the shock absorber devices of Wasdell. By reason of the property of the SE-IOOU, an unvulcanized elastomer, of resisting a suddenly applied force, such material will not function properly in a shock absorber of the Wasdell type.

The levelers of counter-defendants do not meet the requirement of claim 1 of the Wasdell patent to the effect that the chambers and means of communication in such levelers are completely filled by the filling material. Wasdell directs his invention solely to shock absorbers for vehicular use and neither suggests use of any of the disclosed forms of shock absorbers as a self-adjusting leveler nor suggests the modifications necessary to the disclosed shock absorbers to convert the same for functioning as self-adjusting furniture levelers. The accused . . . levelers are not shock absorbers.

In addition to these findings of substantial dissimilarity, there was a complete failure by Stewart-Warner to make any serious attempt to read the Wasdell patent on the accused levelers of the plaintiffs and defendant. Stewart-Warner and its subsidiary Bassick in effect admitted their insincere efforts to equate the levelers manufactured in conformity with the Blake patent and the teachings of the Wasdell patent by the following statement in their brief:

> The counterclaim and suit for infringement of the Wasdell patent were, of course, filed for the purpose of protecting Bassick and Stewart-Warner against the possibility that the District Court would hold bouncing putty and unvulcanized silicone rubber to be equivalent materials, despite their great differences. While Bassick and Stewart-Warner did not consider that the materials were in fact equivalent, they felt that if the Court should hold them to be equivalent, they should be entitled to rely on such a holding for the purpose of interpreting the claims of the Wasdell patent, to the same extent the Blake group could take advantage of such a holding in applying the claims of the Blake patent.

Moreover, counsel for Stewart-Warner and Bassick candidly admitted throughout the trial that the Wasdell patent was not infringed.

Stewart-Warner's "hedge," first in purchasing a patent concededly nonanologous to the patent in controversy after being charged with infringement and thereafter in launching a counter-offensive based on this belatedly acquired patent, was obviously vexatious and done solely to harass the opposing parties. A ploy of this kind ought to be discouraged by exacting a penalty—the award of attorneys' fees in defending an admittedly frivolous counter-action.

Consequently, I believe that Stewart-Warner's counterclaim and complaint based on alleged infringement of the Wasdell patent should have been characterized as "exceptional" cases under 35 U.S.C. § 285, allowing "reasonable attorney fees to the prevailing party."

APPENDIX B

Judgment of the Court of Appeals

IN THE
UNITED STATES COURT OF APPEALS
FOR THE SEVENTH CIRCUIT

Chicago, Illinois 60604
Monday, February 26, 1968

Before
Hon. ROGER J. KILEY, *Circuit Judge*
Hon. LUTHER M. SWYGERT, *Circuit Judge*
Hon. THOMAS E. FAIRCHILD, *Circuit Judge*

DAVID R. BLAKE, an individual, and EVER-LEVEL GLIDES, INC., a corp.,
Plaintiffs-Appellees (Cross Appellants)

Nos. 16213, 16215 vs.

THE BASSICK COMPANY, a corp., and STEWART-WARNER CORP., a corp.,
Defendants-Appellants, (Cross Appellees)

STEWART-WARNER, a corp.,
Plaintiff-Appellee,

No. 16214 vs.

AMERICAN SEATING, a corp.,
Defendant-Appellant.

Appeals from the United States District Court for the Northern District of Illinois, Eastern Division

This cause came on to be heard on the transcript of the record from the United States District Court for the

Northern District of Illinois, Eastern Division, and was argued by counsel.

On consideration whereof, it is ordered and adjudged by this court that the judgments of the said District Court in this cause appealed from be, and the same are hereby, AFFIRMED, in accordance with the opinion of this Court filed this day.

It is further ordered and adjudged by this Court that the costs in this appeals be taxed as follows: ¼ against David R. Blake, Ever-Level Glides, Inc., and American Seating Company; and ¾ against The Bassick Company and Stewart-Warner Corp.

APPENDIX C

Opinion of the District Court

879 IN THE UNITED STATES DISTRICT COURT

* * (Caption—Civil Action No. 62 C 694 and Civil Action No. 62 C 2112) * *

DECISION ON MERITS
(Filed—January 19, 1967)

Although the instrumentality involved in the Blake patent, No. 2,704,663, suit is relatively simple, which fact might tend to obscure the degree of inventiveness involved, the court, after a careful review of the record, concludes that the Blake patent is both valid and infringed, and defendant Stewart-Warner's Wasdell patent, No. 2,503,143, is invalid and is not infringed.

880 Cause No. 62 C 2112 concerns the Wasdell patent, No. 2,503,143, owned by Stewart-Warner Corporation. The patent issued April 4, 1950, and, since the filing of this suit on March 26, 1962, was acquired by Stewart-Warner on September 21, 1962, and was also made the basis of it counterclaim filed November 21, 1962, in 62 C 694, charging infringement by Blake. Ever-Level Glides, Inc. and American Seating Company, and seeking an injunction and damages.

Blake and Ever-Level Glides, Inc. are plaintiffs in 62 C 694 involving the validity of the Blake patent and charging defendants Bassick Company and Stewart-Warner Corporation with infringement. Cause 62 C 2112, consolidated with 62 C 694, also was predicated on the Wasdell patent, and charged infringement by the American Seating Company, which was on June 24, 1954, granted restricted exclusive license of the Blake intention in the public seating field (such as schools and theatres). Ever-Level Glides, Inc. on April 6, 1960, was granted an exclusive license of the Blake device on furniture and equipment in the restaurant and cafeteria field.

The Bassick Company, since the institution of the proceedings, merged with the Stewart-Warner Corporation, the latter being the surviving corporation.

The application for the Blake patent was filed July 24, 1948, and issued March 22, 1955, containing two claims. The original application stated the only prior foreign application was in Great Britain, filed April 26, 1948, and the complete specification published November 28, 1951.

On January 2, 1963, Blake petitioned the Patent Of-
881 fice for a retroactive license under the statute, 35 U.S.C. § 184. It was denied April 4, 1963, and renewed May 15, 1963, and approved May 16, 1963.

A prior patent application by Blake had been filed October 24, 1946, and was abandoned, but during its pendency, the application, which resulted in the Blake patent, was filed.

Blake's invention lay in the combination of the unique qualities of a previously patented substance, "bouncing putty" or silicone putty, in a leveling device which is affixed to the legs of a table, and within a matter of minutes makes an adjustment to an uneven floor, resulting in stability of the table. It is used on restaurant tables, school tables, and the like. Blake's testimony, which is corroborated by documentary records, reveals that there was a real need for this device. Prior thereto had been only a manually adjustable device, which adjustment would need revision if the table were moved and the physical condition of the floor changed. After Blake began working on his levelers in 1940, he tried many fillers for his device, which were ineffective, before he conceived the idea of using bouncing putty, which he learned about in 1946. No use had been found by General Electric or Dow Corning Corporation for bouncing putty as of August 12, 1947.

A simple description of the function of the Blake patent and its component parts is found at the beginning of the patent specifications:

882 "This invention relates to leveling devices for furniture and the like, and its chief object is to provide simple automatic devices for preventing tables, cabinets, refrigerators and other articles and ma-

chines from rocking when they are resting on an uneven floor.

"One of the principal features of this invention is the simplicity of the devices. The essential elements of each device consist merely of a dashpot with a piston and a spring to extend it, some means like a screw or a nail for fixing the piston to the end of a table leg or other support, and a filling of a peculiar substance called 'bouncing putty' to keep the dashpot from compressing quickly under a load.

"Bouncing putty has a unique combination of the properties of a liquid and a solid. One [sic] the one hand, it will deform slowly under the slightest force, like a very viscous liquid, and there is no limit to how far it will deform, as long as the force applied to it is not great enough and applied suddenly enough to break it. A lump of it placed in a container will spread out under merely its own weight and in a few hours cover the bottom of the container like a liquid. On the other hand, it will not flow quickly; it resists sudden forces as if it were a solid. Its rigidity under sudden forces is like that of rubber rather than like that of steel, and a round lump if it will bounce like a rubber ball.

* * *

"Because bouncing putty has these properties [self adhesion and high surface tension], the dashpot can be made very simply with large clearances and with no check values, piston rings, packing glands, flexible diaphragms, bellows, or other seals to keep the filling from flowing past the piston too fast or from leaking out."

The Bassick devices use the substance SE-100U as a filling material, and the Blake and Ever-Level Glides, Inc., and the American Seating Company devices use the material SS-91, or a product derived therefrom, as filling material. All the filling materials are purchased from the General Electric Company.

It is asserted that the Blake leveling device has met with extraordinary public acceptance and in large measure had supplanted other types of glides.

883 Bassick raises the standard challenges to validity of the Blake patent—prior publication, prior patents, filing of a foreign application for the same invention earlier than six months after the United States application; inadequate disclosure by the patent; lack of true invention; estoppel to broad interpretation of claims because of narrowing of coverage in the Patent Office; invalidity of the retroactive license granted Blake on May 16, 1963, in respect to the foreign filing of the Blake invention in England; estoppel to enforce the Blake patent because of defendant's intervening rights by manufacture of the alleged infringing device prior to plaintiff's securing the retroactive license.

Plaintiffs negate infringement of the defendants' Wasdell patent in that it is adapted for conventional use in connection with the usual suspension springs of a vehicle or other device for the purpose of damping out undesirable vibrations set up by the flexing of such springs. Plaintiffs also advance the usual bases for challenging the validity of the Wasdell patent.

Plaintiffs insist Blake has produced a new and useful result (Minneapolis-Honeywell Regulator Co. v. Midwestern Instruments, Inc., 298 F.2d 36 (7th Cir. 1962)) entitled to the statutory presumption of validity (35 U.S.C. § 282; Anderson Company v. Sears Roebuck and Co., 265 F.2d 755 (7th Cir. 1959)), which presumption is enhanced when the application received detailed consideration in the Patent Office (Modern Products Supply Co. v. Drachenberg, 152 F.2d 203 (6th Cir. 1945)). It filled a long-felt need (Charles Peckat Mfg. Co. v. Jacobs, 178 F.2d 794 (7th Cir. 1949); Blaw-Knox Co. v. I. D. 884 Lain Co., 230 F.2d 373 (7th Cir. 1956)). Its commercial success attests to its inventiveness (Goodyear Tire & Rubber Co., Inc. v. Ray-O-Vac Company, 321 U.S. 275 (19944).

Plaintiffs maintain there has been no other successful automatic leveler either before or after Blake. He has been selling the device commercially since the middle of 1947. Over seven million levelers have been sold between 1950 and 1963 by Ever-Level Glides, Inc. after its license from Blake, who had sold a million of them before that.

American Seating Company has sold over five million glides under its license. Even Bassick and Stewart-Warner Corporation sought licenses under the Blake patent, American Seating Company sales of furniture with the levelers doubled in comparison to those without them.

Plaintiffs insist the shock absorber art is nonanalogous to the leveler art (Copeman Laboratories Co. v. General Plastics Corp., 149 F.2d 962 (7th Cir. 1945)).

Plaintiffs base their charge of willful and wanton infringement on the fact that Bassick, the leader in its field of manufacture, had no interest in automatic glides until its customers asked for one similar to Ever-Level's. Bassick got a sample of plaintiff's glide and in 1957 asked for a license under Blake's patent, and when advised that existing licenses covered restaurant and public seating it said it wasn't interested. Bassick assigned its engineers to seek a noninfringing device comparable to plaintiffs'. It continued such study until 1960 when its accused device was marketed. Defendants' years of work to circumvent plaintiffs' invention resulted in a device of only insignificant differences.

885 Plaintiffs refute infringement of claim 1 of the Wasdell patent because its filler, SS-91, is not an unvulcanized elastomer. Mere use of the dash pot does not make the plaintiffs' leveler a shock absorber, and SS-91 cannot be used in Wasdell's shock absorber device, which is directed solely to vehicular use. It was not one which could be bottomed, whereas plaintiffs' device contemplates the leveler remaining bottomed out during its operational use.

Plaintiffs cite there can be no infringement where the device operates in a different manner and with a different result (Electric Railroad Signal Co. v. Hall Railway Signal Co., 114 U.S. 87 (1885)). A shock absorber must be capable of instant response.

A patent on a plurality of elements cannot be infringed where there is an omission of any of the elements (Edwards v. Hychex Products, 171 F.2d 259 (7th Cir. 1948)). Plaintiffs' SS-91 is not technically an unvulcanized elastomer; it has never been vulcanized.

Further, the Wasdell patent requires the shock absorber to be completely filled whereas Blake's leveler is specifically not completely filled, except when bottomed out.

Plaintiffs assert invalidity of the Wasdell patent on the ground of its vagueness at the very point of asserted invention, i.e., "unvulcanized elastomer" in claim 1, as demonstrated by the inoperativeness of SE-100U in a court demonstration of a shock absorber. Blake's SS-91 is not technically an "unvulcanized elastomer." It cannot successfully be used in shock absorbers. Plain-
886 tiffs even seek an award of attorneys' fees on the basis the charge of infringement of the Wasdell patent is frivolous and vexatious (35 U.S.C. § 285). In fact, defendants in their counsel's opening statement said it was their position that neither patent was infringed.

Plaintiffs stress the nonanalogous character of the shock absorber art and the furniture leveler art. The former uses oil. Levelers do not function as shock absorbers and have never been advertised to do so.

Defendants state their basic position to be that "neither patent is infringed" but "if the Blake patent is accorded a measure of equivalence sufficient to encompass the accused Bassick structure, then the Stewart-Warner [Wasdell] patent, by that same measure of equivalence in reverse, encompasses the structures fabricated by the Blake group." Defendants continue, "Although Blake is the innovator of what appears to be the first commercially successful anti-wobble device, his glide operates in accordance with broad principles known in the prior art."

Defendants maintain that when they found they could get no license under plaintiffs' patent they set out to devise one of their own, and did so, and used three elements which Blake had told the Patent Office would not operate in a glide of his design, using unvulcanized silicone rubber, a strong supporting spring, and an O-ring seal.

Defendants insist that the glide described in the Blake patent was similar to that described in the German Patent No. 640,708 to Robkopf in 1936.

887 Defendants point out that Blake's invention resides in the use of the material, bouncing putty, and is limited thereto because both of the two patent claims expressly so limit the invention. Furthermore, bouncing putty, has a precise meaning with a particular chemical composition and flow characteristics. Defendants' SE-100U is not a bouncing putty and does not meet the chemical and physical requirements because it does not have the essential ingredient boron and does not have the free flow phenomena evidencing liquid flow characteristics, nor the sudden force shattering phenomena. The Blake patent claims limit a structure with a spring located inside the dash pot and not with the spring located on the outside of the dash pot chamber between the cover plate and a stop on the piston rod.

Defendants claim plaintiffs are not entitled to invoke the doctrine of equivalence inasmuch as they are limited by estoppel to a strict construction of the patent because of the history of the patent in the Patent Office (Lewis v. Avco Manufacturing Corp., 228 F.2d 919 (7th Cir. 1959); Exhibit Supply Co. v. Ace Patents Corp., 315 U.S. 126 (1942)). Once having narrowed the claims, the patentee is limited thereto (Ekco Products Co., Inc. v. Chicago Metallic Manufacturing Co., 347 F.2d 453 (7th Cir. 1965)). Of the 27 claims which Blake presented to the Patent Office but two were allowed, and both were limited to bouncing putty. In some of the other claims, materials such as Bassick's unvulcanized silicone rubber, SE-100U, were included, i.e., an "organo-siloxane in the plastic state," which is what SE-100U is. The allowed claims cannot be enlarged to include that which was in the 888 rejected claims (Schriber-Schroth Co. v. Cleveland Trust Co., et al., 311 U.S. 211 (1940)). Having disclaimed unvulcanized silicone rubbers he cannot now reclaim the organo-siloxanes. No broader interpretation should be given to the term "bouncing putty."

Defendants also claim a file wrapper estoppel with respect to the location of the spring in the Blake patent, that it must be confined within the chamber or dash pot, either below the piston and the bottom of the chamber or

the piston and the top of the chamber. Thus Bassick is precluded from a charge of infringement because its spring is outside the chamber. Several of the cancelled claims had the spring outside the chamber, so there is estoppel to so interpret the claims (Keating v. Stearnes Imperial Co., 347 F.2d 444 (7th Cir. 1965)). On the other hand, plaintiffs claim the location of the spring within the dash pot is not critical, and the statement of its position would have been eliminated if it had so understood it. Defendants insist their product cannot be within the Blake patent because it uses a strong spring, an unvulcanized silicone rubber and an O-ring seal to prevent leakage and these were precisely the things that Blake insisted could not work. They cite an affidavit filed in the Patent Office which states the spring must be very weak in proportion to the weight of the article with which the device is being used.

While the plaintiffs' and defendants' glides perform the same function, defendants insist they do not do it by means and modes of operation which are equivalent.
889 Defendants stress that unvulcanized silicone rubber is not the equivalent of bouncing putty. Defendants state the testimony proves that its SE-100U had only one of the three flow states of bouncing putty, i.e., visco-elastic plastic solid, regardless of the rate of of application of the applied force, and it does not act as a liquid when pressures are slowly applied, nor as a rigid solid under a suddenly applied force. It is proved by the fact that the bouncing putty filler needs no seal because it solidifies, but the defendants' material needs a seal and can be pumped out of the glide by the piston motion.

Defendants also point out that their strong springs are not the equivalent of Blake's weak springs, and that while the patent makes no reference to the strength of the springs, Blake represented to the Patent Office many times the need for weak springs so as to achieve full compression, which defendants' strong spring does not achieve. The strong spring strength so changes the operation of the glide that it precludes a determination of equivalence. None of the Bassick glides bottoms out

under the weight of a table. There is a significant relationship between the spring strength and the filler material used in the glides. The springs bear the load in the Bassick glide. In the Blake glide the sole function of the spring is to maintain the fourth glide elongated while the other three are bottomed out, so the spring need only be strong enough to force the bouncing putty around the piston from the one side to the other. The spring performs little, if any, load bearing function. The spring 890 performs the single primary function in the Blake implement of extending the device and the bouncing putty performs the shock resisting function. On the other hand, the Bassick spring supports the load, elongates the glide if no load is placed on it, and has the strength to push the piston through the filling medium which has no liquid state under slowly applied forces, so the spring has to have substantial strength. The spring also absorbs much of any sudden shock. The only function of the filling material in the Bassick glide is to dampen the movement of the piston.

Bassick eschews the value of the court demonstrations of the respective glides of plaintiffs and defendants, maintaining that the weights on defendants' table were not heavy enough to compress fully the Bassick glides because of the strength of the springs. While witness Richard M. Savage on deposition testified that the glides were all equivalent, his testimony refutes the conclusion because he stressed the difference in the filling materials, and the difference in the piston action. He made only simple tests of the glides themselves, not on a table. Defendants insist that while the glides perform substantially the same function, they lack the identity of means and mode of operation required in this circuit for a showing of equivalency (Independent Pneumatic Tool Co. v. Chicago Pneumatic Tool Co., 194 F.2d 945 (7th Cir. 1952)).

Blake's claims are directed to a combination of old elements, defendants say, which must be carefully scrutinized because of the improbability of finding invention in an assembly of old elements (Great Atlantic & Pacific

Tea Co. v. Supermarket Equipment Corp., 340 U.S. 147 (1950); Powder Power Tool Corp. v. Powder Actu-
891 ated Tool Co., 230 F.2d 409 (7th Cir. 1956)).

Defendants believe that if the Patent Office had had before it the additional prior art of the Herz patent No. 1,114,691, Hussman No. 2,359,917, Gerb No. 2,148,937 and Wasdell No. 2,503,143, they would not have granted the patent over those devices covered by the Robkopf German patent No. 640,708, the Bazley patent No. 2,460,116, and Henley patent No. 1,461,091. Each of the uncited patents shows a dash pot having a piston with large clearances and a viscous or plastic filling medium in the chamber, the precise features on which the Board of Appeals of the Patent Office based its finding of patentability..

Defendants further assert plaintiffs are in a dilemma as to "bouncing putty," they must give it a narrow construction in order to uphold their patent over the prior art, and they must give it a broad construction in order to encompass defendants' glides with the markedly different substance SE-100U as filler. Plaintiffs may not claim inventiveness by utilizing a new material upon its becoming commercially available (Ruben Condenser Co. et al. v. Aerovox Corp., 77 F.2d 266 (2nd Cir. 1935); Johnson & Johnson v. Kendall Co., 327 F.2d 391 (7th Cir. 1964)).

Another defense which defendants raise is that the Blake patent is invalid because of a prior public use. They cite the filing of the patent application on July 24, 1948, but state that he had theretofore mailed a set of glides on January 10, 1947, to a friend, to serve as a
basis for his trademark registration No. 502,308.
892 The friend used the glides on his chair and demonstrated the use to others, which is a public use under the decision of Egbert v. Lippmann, 104 U.S. 333 (1881), and Randolph v. Allis-Chalmers Manufacturing Co., 264 F.2d 533 (7th Cir. 1959)). Thereupon the patentee has the burden of proving the use was not a public use. Use for experimental purposes must be solely connected with that purpose (Hobbs v. Wisconsin Power & Light Co., 250 F.2d 100 (7th Cir. 1957)). (Plaintiffs claim this was

an experimental use.) Since Blake is not entitled to his earlier application date, and since the use was for purely social purposes and to establish his trademark rights, there was an invalidating public use more than a year prior to his application.

Defendants maintain that Congressional legislative history refutes the conclusion that an issued patent could be validated by a retroactively procured license, such as Blake received. Furthermore, Blake's license is invalid because he procured it by misrepresentation. They point out that "bouncing putty" never appeared in the original United States (abandoned) application, but first appeared in the British provisional specification. Blake stated to the Patent Office that he had prepared and filed his British provisional specification without the aid of an attorney, but his deposition reveals that his patent attorney prepared it, therefore his license is void, and consequently the patent is invalid (35 U.S.C. § 185).

Defendants believe they are protected by the equitable estoppel doctrine or intervening rights principle and the Blake patent is unenforceable as against them because they entered the field before the granting of a retro-
893 active license and would have no way of knowing that the patentee would be able to prove inadvertence in prior foreign filing (Sontag Chain Stores Co., Ltd., v. National Nut Company of California, 310 U.S. 281 (1940)).

Plaintiffs stress the comparison is not to be made of defendants' material SE-100U with plaintiffs' SS-91, but whether defendants' SE-100U can be considered a "bouncing putty" within the purview of the patent. The claims when read in the light of the specifications as permitted by law, disclose a putty-like substance which resists a suddenly applied force and deforms slowly in response to a steadily applied force. Since SE-100U was not in existence at the time of the patent, it was not then known, but nevertheless had the physical characteristics delimited by the patent which was meant to cover future compounds.

Plaintiffs insist they cannot be held to infringe claim 1 of the Wasdell patent because their material SS-91 is

not an unvulcanized elastomer. Neither could defendants' SE-100U be used in the Wasdell shock absorber. On the other hand, aside from "highly technical chemical distinctions" for all practical purposes, defendants' SE-100U is the equivalent of SS-91 insofar as they function in the glide. SE-100U resists a suddenly applied force and flows under a steadily applied force.

Despite the many seemingly plausible legal arguments advanced by the defendants to refute validity and infringement by them of the Blake patent, and to establish validity and infringement by plaintiffs of the Wasdell 894 patent, the court is convinced that the Blake patent is valid and infringed and the Wasdell patent is invalid and not infringed.

The court cannot ascribe to the prior art the clarity of revelation and anticipation which defendants accord it. Blake worked for many years to achieve his invention, and defendants worked several more years, after failing to procure a license under Blake, to construct a workable glide. If the prior art were as revealing as defendants claim, the experimentation should have been brief, or not at all necessary. The uniqueness of the application of bouncing putty to glides was attested by the vice president of General Electric Company writing on September 27, 1949, terming the combination an "ingenious idea."

The court is of the opinion that the shock absorber art is not analogous to that of glides. They were not aimed at serving the same function—that of the shock absorber, as its name states, was to take the brunt of sudden force. The glide is to make a level plane out of an uneven surface by automatic adjustment of the glides to compensate for the uneven surface. The only similarity would seem to be the use of containers in the form of a dash pot. The filling materials in the respective arts are entirely different, and serve different functions.

The court deems neither the relative strength of the springs nor their precise positions sufficient to absolve defendants from infringement, neither being of true significance in the patent combination but merely recom-

mended features in the device. Nor does the plaintiffs' leveler infringe the Wasdell patent, inasmuch as its filling material, SS-91, is not an unvulcanized elastomer and is not capable of being vulcanized into elastomeric form.

895 The court is of the opinion that the plaintiffs' interpretation is correct of the interrelation of the patent statute sections, 102(a) and (g), (e) and 119, as expounded in Application of Hans Hilmer, Gerhard Korger, Rudi Weyer and Walter Aumuller, 359 F.2d 859 (C.C.P.A. 1966), i.e., that the earlier foreign filing date does not entitle it to the standing of a prior art reference as of that date, but only as of the United States filing date.

The court has concluded to adopt the findings and conclusions submitted by Blake and Ever-Level Glides, Inc. as the court's findings. They are completely in accord with the court's review of the evidence. For the court to reformulate the findings would be sheer duplication of effort and a needless expenditure of the court's time (Heterochemical Corporation v. United States Rubber Company, 368 F.2d 169 (7th Cir. 1966)).

/s/ Edwin A. Robson,

January 19, 1967

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UNITED STATES DISTRICT COURT

Name of Presiding Judge, Honorable Edwin A. Robson

Cause No. 62 C 694, 62 C 2112 Date February 13, 1967

Title of Cause Blake v. Bassick

Brief Statement of Motion—Motion to Amend Decision on Merits

Enter Order:

Granting Motion to The Bassick Company and Stewart-Warner Corporation to Amend the Decision on the Merits, there having been no intention to find wilful and wanton infringement nor to award treble damages and attorneys' fees, and the adoption on the plaintiffs' findings in respect thereto was inadvertent.